

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL STEFFE

Appeal No. 2002-0978
Application 09/535,065

ON BRIEF

Before COHEN, PATE, and NASE, **Administrative Patent Judges.**

PATE, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal from the final rejection of claims 12 through 22.

These are all of the claims in the application.

Claims 1 through 11 were subject to a restriction requirement and have been canceled.

The claimed invention is directed to a racheting open-end wrench.

The wrench has a fixed jaw rigid with the wrench handle, and a movable jaw that coacts with the fixed jaw such that both sides of a nut can be engaged.

The claimed subject matter may be further understood with reference to the appealed claims appended to appellant's brief.

THE REJECTIONS

Claims 12 through 22 stand finally rejected under 35 U.S.C. § 112, first paragraph as "containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed had possession of the claimed invention." The examiner refers to page 25 of the specification wherein it is stated that the angle between the jaw face 178a and the guide surface 198 is about 10° to 12°. However it is further stated that this angle is preferably 10° or less. According to the examiner, the preferred range is outside the stated range of 10° to 12° and therefore, the disclosure with respect to this embodiment cannot be understood.

Claims 12 through 22 stand finally rejected under U.S.C. § 112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter

which appellant regards as the invention. According to the examiner, claim 12 appears to claim two separate movable jaws. Therefore, the claim is ambiguous. The examiner further states that there is no antecedent basis for "the wedge-shaped movable jaw" in claims 21 and 22. The examiner is of the view that claim 22 is directed to some type of kit with interchangeable jaws.

OPINION

We have carefully reviewed the claims on appeal in light of the arguments of the appellant and the examiner. As a result of this review, we have reached the conclusion that the claims do not lack written descriptive support and are not indefinite. Accordingly, the rejections on appeal are reversed. Our reasons follow.

Whether a specification complies with the written description requirement of 35 U.S.C. § 112, first paragraph, is a question of fact. ***Regents of Univ. of Cal. v. Eli Lilly and Co.***, 119 F.3d 1559, 1566, 43 USPQ2d 1398, 1404 (Fed. Cir. 1997), ***cert. denied***, 523 U.S. 1089 (1998) (***citing Vas-Cath Inc. v. Mahurkar***, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116 (Fed. Cir. 1991)). To fulfill the written description requirement, a patent specification must describe an invention and do so in sufficient

detail that one skilled in the art can clearly conclude that "the inventor invented the claimed invention." *Id. citing Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572, 41 USPQ2d 1961, 1966 (Fed. Cir. 1997) *and In re Gosteli*, 872 F.2d 1008, 1012, 10 USPQ2d 1614, 1618 (Fed. Cir. 1989) ("[T]he description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed."). Thus, an applicant complies with the written description requirement "by describing the invention, with all its claimed limitations, not that which makes it obvious," and by using "such descriptive means as words, structures, figures, diagrams, formulas, etc., that set forth the claimed invention." *Id. citing Lockwood*, 107 F.3d at 1572, 41 USPQ2d at 1966.

It is important to note that it is the written description of the *claimed subject matter* that is of concern. In this instance, it is our finding that the claims on appeal do not include the limitation of "an angle of about 10° to 12°, preferably 10° or less..." that the examiner has pointed to as the ground of rejection. While such phraseology may well be a ground for an objection to appellant's specification, it can not

serve as a basis for a rejection, since it is not a claimed feature. Accordingly, the written description rejection of claims 12-22 is reversed.

With regard to the second paragraph requirement for "particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention," it has been stated that the "essence of that requirement is that the language of the claims must make it clear what subject matter they encompass." *In re Hammack*, 427 F.2d 1378, 1382, 166 USPQ 204, 208 (CCPA 1970). This has been frequently stated in a shortened form as a requirement that the claims set forth the "metes and bounds" of their coverage. *See, merely for example, In re Venezia*, 530 F.2d 956, 958, 189 USPQ 149, 151 (CCPA 1976); *In re Goffe*, 526 F.2d 1393, 1397, 188 USPQ 131, 135 (CCPA 1975); *In re Watson*, 517 F.2d 465, 477, 186 USPQ 11, 20 (CCPA 1975); *In re Knowlton*, 481 F.2d 1357, 1366, 178 USPQ 486, 492 (CCPA 1973).

With respect to the rejection under 35 U.S.C. § 112, second paragraph, we are of the view that claim 12 does not specify two movable jaws as stated by the examiner. The phrase "to slidably guide a movable jaw" is seen to refer to the movable jaw

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positively recited in the next paragraph. With respect to claims 21 and 22, the "wedge shaped movable jaw" recited in parent claim 12 is not a separate piece from the movable jaw also recited in the claim. As to the examiner's observations regarding a "kit" and claim 22, the examiner fails to state a convincing reason why the claim, even if directed to a kit, would be indefinite. It appears that the examiner has been able to determine the metes and bounds of this claim. It is our opinion that claims 12, 21 and 22 are not indefinite under section 112.

The rejections on appeal are reversed.

REVERSED

IRWIN CHARLES COHEN)	
Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
WILLIAM F. PATE III)	
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